

PRE-APPEAL BRIEF REQUEST FOR REVIEW
- Expedited Examining Procedure -
Examining Group 2625

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Inventor(s):

John R. Fredlund, et al.

**SYSTEM AND METHOD FOR
PROVIDING UNOBTAINABLE
HUMAN VISIBLE INFORMATION
ON A PRINT**

Serial No.: 10/020,538

Filed: November 30, 2001

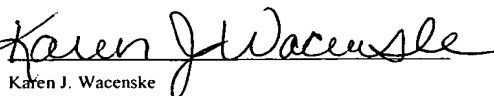
Commissioner for Patents
Alexandria, VA 22313-1450

Group Art Unit: 2625

Examiner:

Beniyam Menberu

I hereby certify that this correspondence is being deposited today with
the United States Postal Services as First Class Mail in an envelope
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Karen J. Wacenske

2-1-07
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request pre-appeal brief review of the final Office Action dated November 1, 2006, and the Advisory Action dated January 19, 2007, in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. It was not indicated if the Amendment filed December 11, 2006, amending the specification and submitting formal drawings, was entered. Applicants presume this response was entered, and the claims are as submitted in the response filed August 7, 2006.

Claims 2-11, 13, 15, 16, 18, 24-26, 28, and 30-34, as well as claim 27 (argued but not listed), are rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,530,759 to Braudaway et al. in view of U.S. Patent No. 6,304,345 to Patton et al. Claims 12, 17 and 29 are rejected under 35 U.S.C. 103(a) over Braudaway et al. in view of Patton et al. and further in view of U.S. Patent No. 6,563,542 to Hatakenaka et al. For at least the following reasons, Applicants submit the Examiner has failed to provide a *prima facie* case of obviousness.

The primary reference of Braudaway et al., and the combination of Braudaway et al. and the tertiary reference of Hatakenaka et al., were applied in the

first Office Action of 12 October 2005 and overcome by incorporating allowable subject matter into the independent claims. The incorporated subject matter was determining an optimum location for the human visible information based on a spatial analysis of the image. The Examiner subsequently has admitted that Braudaway et al. does not teach this feature of the claimed invention, and does not teach that the human readable information is not obtrusive. See, for example, page 4 of the final Office Action. Hatakenaka et al. is also not relied upon for these teachings. Thus, only the reference of Patton et al. is relied on for the teachings that the human visible information is placed in an optimum location based on a spatial analysis of the image, and that the information is not obtrusive.

As previously explained in the remarks of the December 11, 2006, Amendment, incorporated herein by reference, Patton et al. is directed to a method of encoding data regarding the original colorimetric values of certain areas of a print on a hardcopy image of the print. Such data is either provided (1) on the print itself in such a manner as to be invisible to the viewer, or (2) in human readable form in the margins of the print outside the viewable area. This is supported by the sections of Patton et al. cited by the Examiner in the final Office Action and the Advisory Action, col. 4, lines 50-55, and col. 9, lines 21-24, discussed herein below.

Col. 4, lines 50-55, reads:

In the preferred embodiment, informational data 14 is provided on the print in the area of the image 12 in a manner that is visually indistinguishable from the image 12. (Emphasis added.)

As stated, Patton et al. teaches that the information is present on the picture in a manner that is visually indistinguishable to a human. As defined in the Compact Oxford English Dictionary

(http://www.askoxford.com/concise_oed/indistinguishable?view=uk),

“indistinguishable” means “*not able to be identified as different or distinct.*” Merriam Webster’s Online Dictionary, Tenth Edition (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=indistinguishable>), defines “indistinguishable”

as “*not distinguishable: as a : indeterminate in shape or structure <indistinguishable forms in the mist> b : not clearly recognizable or understandable <indistinguishable differences>*,” and provides a thesaurus entry of “*imperceptible*,” defined as “not seen.” Thus, the visually indistinguishable information of Patton et al. located on the image is imperceptible, or not seen by a human.

In contrast, Applicants claim providing information wherein the “human visible information is not obtrusive.” Applicants provided a visual example of such information in the response of December 11, 2006. As can be seen by study of the second image provided, on a casual glance, the information is difficult to see. However, it is readily visible and readable once pointed out. The information is incorporated into the image in an unobtrusive manner such that a person knowing of its presence will see it. In contrast, Patton et al. teaches that any information within the image area is not visible to a human, being indistinguishable from the image.

For support of a showing of information that is “not obtrusive,” the Examiner also references col. 9, lines 21-24, alternately referred to as lines 20-25 or 21-24 by the Examiner, which reads:

The colorimetric and location information may be encoded in a non-pictorial image area on the front of the hardcopy print or on the back of the print in a manner that is human readable or encoded.

Applicant believes the Examiner may be asserting that “non-pictorial image area” is an area *within* the image selected by spatial analysis. However, no analysis of the image is taught. Further, the front and back of the print are referenced, wherein at least the back of the print does not include an image. Further reference to the non-image area is made at col. 7, lines 14-22, of the specification, which reads:

If a change model is available for the print material of the print 12 from a database selected based on encoded information on the non-image area of the front or back of the print, or on ancillary knowledge of the print material itself, or is encoded in the image 12 that describes the fading function for the actual medium on which the original image was made,

As shown in the referenced area of col. 7, a “non-image area” is differentiated from an area in the image, and therefore must be outside the image. While Applicants recognize the terms “non-image area” and “non-pictorial image area” are different, each term is used only once, and the two terms appear in context to mean the same thing. Thus, Applicants submit “non-pictorial image area” is an area outside the pictorial image, not an area within the image as apparently asserted by the Examiner.

Although the Examiner repeatedly points to the combination of col. 4, lines 52-53 or 50-54, and col. 9, lines 23-25, as teaching that the human visible information is not obtrusive, a reading of those sections, set forth above, shows that col. 4 refers to indistinguishable information within an image, and col. 9 refers to human readable

information in a non-image area. It is apparent that the intent of Patton et al. is not to mar the appearance of the image, including information either invisibly (“indistinguishable”) within the image, or visibly outside of the image area.

In contrast, Applicants include information visible within the image, but not obtrusive, such that one must work to notice the information, or have it pointed out to know it is there. Again, Applicants refer to the images submitted in the December 11, 2006 Amendment. Applicants submit the Examiner has failed to make a *prima facie* case of obviousness with regard to a teaching or suggestion by Patton et al., alone or in combination with the other references, of the claimed feature of human visible information within the image that is not obtrusive.

Regarding spatial analysis, the Examiner refers to col. 5, lines 20-33, which reads:

Preferably, the informational data 14 includes colorimetric data regarding the image 12, which in the preferred form of the invention is accomplished by providing at least one specified area 18 having a particular colorimetric value. The specified area 18 is of sufficient size so that an appropriate number of scanner pixel elements are provided having a particular colorimetric attribute. The informational data 14 preferably includes means for identifying the location of the specified area 18 as shown in FIG. 2. The informational data 14 is provided with two coordination points 20, 21 such that the specified area 18 may be located with respect to points 20, 21 thereto. Thus, when the print 10 is scanned, the scanner will search the print for informational data 14 as previously discussed.

The Examiner asserts at page 4 of the final Office Action that this section teaches “determining an optimum location for said human visible information based on a spatial analysis of said image.” This section of the specification indicates that any information 14 on the print includes a coordination point 20,21 of a specified area 18 that has a particular colorimetric value that is to be matched on reprinting. No spatial analysis of the image is done to determine placement of the information, and, as indicated previously, the information is not human visible. Patton et al. teaches identifying areas of the image appropriate for use as a colorimetric sample (*see* col. 5, lines 25-27). There is no teaching of spatial analysis of the image, only colorimetric analysis.

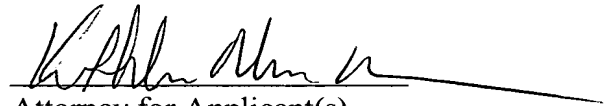
The Examiner further cites col. 5, lines 61-63, which reads:

The code 16 is preferably located in a specified area on the print 10, such as in the upper right quadrant 31 as illustrated in FIGS. 1 and 4 a.

This is merely a statement of a preferred embodiment, and does not indicate spatial analysis of the image. This appears to be a recommendation of consistent placement of the information data 14 in a single location as a standard, which would be logical for ease of determining whether such information is present. *See* col. 5, lines 58-66, describing use of a scanner to find and read the code 16. There is no teaching or suggestion of determination of an optimum location for the information based on spatial analysis of the image, as claimed by Applicants. For at least these reasons, the Examiner has failed to assert a *prima facie* case that Patton et al., alone or in combination with the other references, discloses or suggests at least the claimed feature of performing spatial analysis on an image.

For at least the above reasons, the final Office Action is in error, the Examiner having failed to assert a *prima facie* case of obviousness with regard to all features of the claimed invention. Reconsideration and withdrawal of the rejections of all claims are in order and are respectfully requested. A prompt and favorable action in response to this request is earnestly solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.